

ESTTA Tracking number: **ESTTA388927**

Filing date: **01/18/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sprinkles Cupcakes, Inc.
Granted to Date of previous extension	01/15/2011
Address	9635 Little Santa Monica Boulevard Beverly Hills, CA 90210 UNITED STATES
Attorney information	John Slafsky and Hollis Beth Hire Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94394 UNITED STATES trademarks@wsgr.com, hhire@wsgr.com Phone:650 493 9300

Applicant Information

Application No	85067067	Publication date	11/16/2010
Opposition Filing Date	01/18/2011	Opposition Period Ends	01/15/2011
Applicants	<p>Courville, Donovan 10020 Cade Trail Keller, TX 76244 UNITED STATES</p> <p>Courville, Cari 10020 Cade Trail Keller, TX 76244 UNITED STATES</p>		

Goods/Services Affected by Opposition


Class 030. All goods and services in the class are opposed, namely: frozen yogurt confections and tea
Class 043. All goods and services in the class are opposed, namely: frozen yogurt and tea shop services in the nature of a restaurant

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration	3306772	Application Date	03/03/2006
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No.			
Registration Date	10/09/2007	Foreign Priority Date	NONE
Word Mark	SPRINKLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2004/02/01 First Use In Commerce: 2004/02/01 Bakery goods Class 035. First use: First Use: 2005/04/13 First Use In Commerce: 2005/04/13 Retail shops featuring baked goods		

U.S. Registration No.	3271643	Application Date	08/02/2005
Registration Date	07/31/2007	Foreign Priority Date	NONE
Word Mark	SPRINKLES CUPCAKES		
Design Mark			
Description of Mark	The mark consists of View of top of cupcake with script.		
Goods/Services	Class 030. First use: First Use: 2004/10/19 First Use In Commerce: 2004/10/19 Bakery goods Class 035. First use: First Use: 2005/04/13 First Use In Commerce: 2005/04/13 Retail shops featuring baked goods		

U.S. Registration No.	3250609	Application Date	08/02/2005
Registration Date	06/12/2007	Foreign Priority Date	NONE
Word Mark	SPRINKLES CUPCAKES		

Design Mark	<p>SPRINKLES CUPCAKES</p>
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2004/02/01 First Use In Commerce: 2004/02/01 Bakery goods Class 035. First use: First Use: 2005/04/13 First Use In Commerce: 2005/04/13 Retail shops featuring baked goods

U.S. Registration No.	2938800	Application Date	11/13/2002
Registration Date	04/05/2005	Foreign Priority Date	NONE
Word Mark	SPRINKLES OF PALM BEACH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2002/10/00 First Use In Commerce: 2002/10/00 Ice cream		

U.S. Registration No.	3004757	Application Date	07/16/2003
Registration Date	10/04/2005	Foreign Priority Date	NONE
Word Mark	SPRINKLES PALM BEACH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/10/00 First Use In Commerce: 2002/10/00 Retail store services featuring ice cream		

Attachments	78829040#TMSN.jpeg (1 page)(bytes) 78684128#TMSN.jpeg (1 page)(bytes) 78684122#TMSN.jpeg (1 page)(bytes) 76529862#TMSN.gif (1 page)(bytes) Notice of Opposition (SPRINKLEBERRY)].pdf (7 pages)(181438 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Hollis Beth Hire/
Name	John Slafsky and Hollis Beth Hire
Date	01/18/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Sprinkles Cupcakes, Inc., a Texas corporation,

Opposer,

v.

Cari Courville and Donovan Courville, U.S.
individuals,

Applicants.

NOTICE OF OPPOSITION

Re: Mark: SPRINKLEBERRY
Serial No.: 85/067067
Filed: June 19, 2010
Published: November 16, 2010

Sprinkles Cupcakes, Inc. (“Opposer”), a corporation organized and existing under the laws of the State of Texas, with its principal place of business at 9635 Little Santa Monica Boulevard, Beverly Hills, CA 90210, believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/067067 (the “Application”), and hereby opposes the Application.

As grounds for the opposition, Opposer alleges that:

1. Opposer has obtained all necessary extensions of time to oppose the Application following its publication in the Official Gazette on November 16, 2010.
2. On information and belief, Applicants Cari Courville and Donovan Courville (“Applicants”) are U.S. individuals residing in Texas, and who can be located at 10020 Cade Trail, Keller, Texas 76244.
3. Opposer is the leading gourmet cupcake bakery. Opposer has used the marks SPRINKLES and SPRINKLES CUPCAKES in connection with bakery goods and related retail store

services since at least as early as 2005. Such use has been valid and continuous, and such marks have not been abandoned.

4. Opposer also offers, though a licensee, ice cream and retail store services featuring ice cream under the mark SPRINKLES PALM BEACH.

5. Opposer owns multiple federal applications and registrations (the “Sprinkles Registrations”) for marks incorporating SPRINKLES (the “SPRINKLES Marks”), with priority dates earlier than the June 19, 2010 filing date of Applicants’ intent-to-use Application:

a. Reg. No. 2938800 for SPRINKLES OF PALM BEACH in connection with “ice cream”, registered on April 5, 2005, and claiming a first use date at least as early as October 31, 2002;

b. Reg. No. 3004757 for SPRINKLES PALM BEACH AND DESIGN in connection with “retail store services featuring ice cream”, registered on October 4, 2005, and claiming a first use date at least as early as October 31, 2002;

c. Reg. No. 3250609 for SPRINKLES CUPCAKES in connection with “bakery goods” and “retail shops featuring baked goods”, registered on June 12, 2007, and claiming first use dates at least as early as February 1, 2004 and April 13, 2005;

d. Reg. No. 3271643 for SPRINKLES CUPCAKES AND DESIGN in connection with “bakery goods” and “retail shops featuring baked goods”, registered on July 31, 2007, and claiming first use dates at least as early as October 19, 2004 and April 13, 2005;

e. Reg. No. 3306772 for SPRINKLES in connection with “bakery goods” and “retail shops featuring baked goods”, registered on October 9, 2007, and claiming a first use dates at least as early as February 1, 2004 and April 13, 2005;

f. Reg. No. 3849382 for SPRINKLES CUPCAKES in connection with “pet treats”, registered on September 21, 2010, and claiming a first use date at least as early as April 13, 2005;

g. Reg. No. 3849383 for SPRINKLES CUPCAKES in connection with “serving trays; serving trays with recessed holes to hold cupcakes; serving towers, namely, towers comprised of stacked serving trays”, registered on September 21, 2010, and claiming a first use date at least as early as April 13, 2005;

h. Application Ser. No. 77770532 for SPRINKLESMOBILE in connection with “retail store services featuring baked goods; mobile retail store services for the sale of baked goods from a custom vehicle”, filed on June 29, 2009;

i. Application Ser. No. 77770541 for SPRINKLES in connection with “ice cream; frozen yogurt; candy; sweets; cupcake mixes; ice cream sundaes, sherbets, ices, sorbets, milk shakes”, filed on June 29, 2009;

j. Application Ser. No. 77802907 for ISPRINKLES in connection with “computer software for locating retail stores featuring bakery goods, desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and merchandise, and for providing information about bakery goods, desserts, and merchandise; computer software for mobile devices for locating retail stores featuring bakery goods, desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and

merchandise, and for providing information about bakery goods, desserts, and merchandise”, filed on August 12, 2009;

k. Application Ser. No. 77858599 for SPRINKLES CUPCAKES in connection with “clothing, namely, shirts, tank tops, baby bodysuits, hats”, filed on October 27, 2009, and claiming a first use date at least as early as April 13, 2005;

l. Application Ser. No. 77866405 for SAY IT WITH SPRINKLES in connection with “retail shops featuring baked goods”, filed on November 5, 2009, and claiming a first use date at least as early as September 1, 2009;

m. Application Ser. No. 77868765 for I LOVE SPRINKLES in connection with “bakery goods” and “retail shops featuring baked goods”, filed on November 9, 2009;

n. Application Ser. No. 77872012 for SAY IT WITH SPRINKLES in connection with “bakery goods”, filed on November 13, 2009, and claiming a first use date at least as early as September 1, 2009;

o. Application Ser. No. 77870009 for I LOVE SPRINKLES AND DESIGN in connection with “clothing, namely, shirts, tank tops, baby bodysuits, hats”, filed on November 11, 2009, and claiming a first use date at least as early as February 1, 2006;

6. Opposer has offered its goods and services under the SPRINKLES Marks throughout the United States and has developed valuable goodwill with respect to the marks.

7. By virtue of the efforts and the expenditure of considerable sums for promotional and advertising activities and by virtue of the excellence of its goods and services, Opposer has gained for its SPRINKLES Marks a valuable reputation and has created in the minds of the public an exclusive association between the SPRINKLES Marks and Opposer’s goods and services.

8. On information and belief, on June 19, 2010, Applicants filed an application for SPRINKLEBERRY in the United States Patent and Trademark Office (Application Ser. No. 85/067067) based on intent to use the mark in commerce. On information and belief, the application was published in the Official Gazette on November 16, 2010, with the following identification of goods: “frozen yogurt confections and tea,” in Class 30, and “frozen yogurt and tea shop services in the nature of a restaurant,” in Class 35.

9. On information and belief, Applicants did not use the mark in the Application prior to Opposer’s priority dates.

10. Opposer’s use of and application for the SPRINKLES Marks are prior to Applicants’ use of and applications for the SPRINKLEBERRY mark.

11. The trademark in the Application is likely to be confused with Opposer’s SPRINKLES Marks, because the mark in the Application is confusingly similar in appearance, sound, and meaning to the SPRINKLES Marks, and conveys a confusingly similar commercial impression.

12. The goods and services in the Application are related to the goods and services of Opposer, and use of Applicants’ mark on such goods and services would so nearly resemble Opposer’s use as to be likely to cause confusion, mistake, or deception.

13. Adding to the likelihood of confusion, the SPRINKLEBERRY mark is a combination of Opposer’s well-known SPRINKLES Marks, and the PINKBERRY mark for frozen yogurt, another well known dessert brand.

14. If Applicants are permitted to register the marks in the Applications, Opposer will be damaged because, among other reasons, confusion in the trade and in the public is likely to result, injuring Opposer’s reputation in the trade and with the public. That confusion will also injure the public, in that consumers, upon seeing Applicants’ mark used in connection with Applicants’ goods

and services, are likely to believe that Applicants' goods and services are somehow associated with or approved by Opposer.

WHEREFORE, Opposer prays that Application Serial No. 85/067067 be rejected, that no registrations be issued to Applicants, and that this opposition be sustained in favor of Opposer.

Opposer authorizes payment of the required filing fee of \$600.00 from its counsel's USPTO Deposit Account. Please charge the fee to Deposit Account No. 23-2415 ATTN: 33236-900.

Please address all U.S.P.T.O. communications regarding this Notice of Opposition to:

John L. Slafsky
Hollis Beth Hire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, California 94304-1050
Tel: (650) 493-9300
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trademarks@wsgr.com

Date: January 18, 2011

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 

John L. Slafsky
Hollis Beth Hire
Attorneys for Opposer
Sprinkles Cupcakes, Inc.

CERTIFICATE OF SERVICE BY MAIL

I, Jo Ann Hylton, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

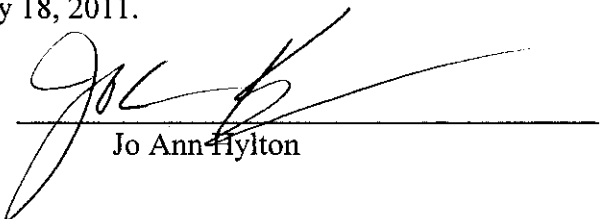
On this date, I served **NOTICE OF OPPOSITION** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Cari Courville
Donovan Courville
10020 Cade Trail
Keller, TX 76244

Catherine Hough
Catherine Hough Law Office, PC
2633 Commerce St.
Dallas, TX 75226-1403

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed at Palo Alto, California on January 18, 2011.


Jo Ann Hylton